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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/542,618	04/04/00	WEHRMANN H	P04357US0 PH

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EXAMINER	
BENZION,G	
ART UNIT	**PAPER NUMBER**
1638	4

DATE MAILED: 10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/542,618	Applicant(s) WEHRMANN ET AL.	
	Examin r Gary Benzion, Ph.D.	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-32 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Status of the application.

This application should be examined for errors.

Claims 1-32 are pending.

DEPOSIT OF BIOLOGICAL MATERIAL.

The statement at page 36 of the specification that indicates applicants' intention to make an enabling deposit of the claimed invention, with the American Type Culture Collection (ATCC), is noted. In the even of the maturation of the application to allowable status, under 37 CFR 1.809(c)(d), the applicants are require to make a deposit of seed of the invention within **three months** after the mailing date of the Notice Of Allowance and Issue Fee Due. The period for satisfying this requirement is **not** extendible under § 1.136 and failure to make an enabling deposit will result in **abandonment of the application for failure to prosecute**. The deposit statement in the specification, and the claims, must be amended to include the deposit accession number. The statement of deposit in the specification must comply with that set forth in 37 CFR 1.801-1.809, and shall contain:

(1) The accession number for the deposit(s);

(2) The date of the deposit(s);

(3) A description of the deposited biological material sufficient to specifically identify and to permit examination; and

(4) The name and address of the depository. (See 37 CFR 1.809(d)).

35 U.S.C.§ 112.

Claim 1-32 rejected under 35 U.S.C. § 112, -second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5 and 7 are incomplete in the recitation of the limitation "representative seed having been deposited under ATCC accession number ____" as found in claims 1, 5 and 7 and in the claims that depend therefrom. In the interest of compact prosecution, Applicants may refrain from amending the claim until the time of the actual deposit as set forth in 37 CFR 1.801-1.809. Failure to amend claim 1, 5 and 7, however, will result in abandonment for failure to prosecute.

Claims 11, 15, 19, 24, 28 and 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of "said maize plant" in each of claims 11, 15, 19, 24, 28 and 32 is both vague and indefinite as it is unclear which maize plant is being referenced. Amending the claim to clearly set forth the maize plant of interest would be seen to obviate this rejection.

The following is a quotation of the first paragraph of 35 § U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-19 are rejected 35 U.S.C.§ 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The limitation of "one or more genes transferred by backcrossing" fail to set the metes and bounds of the invention as the term does not carry with it any limitation as to the structural or physical properties of the genes. For example, the person having skill in the art could insert an additional copy of the rDNA gene from maize, or any other gene from maize, into the selected maize line. Official notice is taken that maize *per se* comprise from 3,000 to 20,000 copies of that rDNA, and the insertion of an additional copy would produce a plant that is indistinguishable from its non-transformed plant. While the specification provides a narrative of the genes within the scope of the claim, the claimed invention is not limited by the instant recitation to those specific embodiments. Furthermore while the specification disclose the physiological and morphological characteristics of corn hybrid 39J26 and, in the event of an acceptable deposit of seed capable of producing this inbred line, enable the person having skill in the art the ability to make and use the invention. The specification does not describe other plants having all the physiological and morphological characteristics of inbred corn line 39J26, nor does it enable the person having skill in the art to make a line having all its physiological and morphological traits as the parental material is propriety, and the selection criteria employed to make 39J26 is not disclosed, nor are genetic or other profiles correlated to the physiological or morphological characteristics. Clearly the claimed invention is broader than that which is enabled by the deposit of seed comprising 39J26 and as such is not

enabled by said deposit. In this regard the decision in *Ex parte Tanksley* (BdPatApp&Int) 37 USPQ2d 1382, is noted. In *Tanksley,* claims to DNA clones which on first analysis appeared to be enabled by a deposit, were later found to be indefinite based on statements made in the specification as to what applicants believed to be DNA equivalents, and thus broader than that warranted by the deposit of material consisting of distinct DNA sequences. In the instant case Applicant's specific contribution is limited to that which will be deposited and its equivalents, to the extent that the claims under question are interpreted to consist of the deposited inbred line 39J26 and plants and seed which are demonstrated to be 39J26 whether presented with or without the trivial name. Similarly, plants by the insertion of one or more genes by a breeding process are not described to the extent that evidence is provided that the applicants' were in possession of the claimed. That is, the claims may be considered to cover the seeds, plants and hybrids made by the use of 39J26 that have not been deposited, so long as said seeds, plants and hybrids have all the physiological and morphological characteristics of 39J26, which is represented by the deposited sample. Alternatively, the claims may be interpreted to include trivial modification of enabled seed, plants and hybrids of 39J26 in which the corn retains all the physiological and morphological characteristics of inbred corn line 39J26, its parts, and hybrids which are not broader than that found enabled by the deposit. As currently claimed, the specification does not teach the metes and bounds of any modification of the instant hybrid and as such the claimed invention is considered to lack an adequate written description of hybrid seed comprising more than the genetic potential of 39J26.

Prior art.

Claims 1-32 are free of the prior art in view of the combined characteristics of the hybrid plant and seed. Claims 1-32 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C.§ 112 set forth in this Office Action.

No claim is allowed.

Inquires

Any inquiry concerning this or earlier communication from the examiner should be directed to Gary Benzion, Ph.D. whose telephone number is (703) 308-1119. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703)-308-4310. Any inquiry of a general nature or relating to the status of this application should be directed to the Patent Analysts,

Gwendolyn Payne, whose telephone number is (703) 305-2475. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Benzion
9/29/01

GARY BENZION, Ph.D.
PRIMARY EXAMINER
GROUP ART UNIT 1638